

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Scott E. Jahns et al.	Examiner:	Lindsey Michele Bachman
Serial No.:	10/763,861	Group Art Unit:	3734
Filed:	January 24, 2008	Docket No.:	M190. 113.101/P-9198.00
Title:	VESSEL SEALING DEVICES		

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This pre-appeal brief is being submitted along with a Notice of Appeal in response to the Office Action mailed on October 29, 2008 and the Advisory Action mailed on February 17, 2009. Claims 1, 3-18, 20-26, 28-29, and 48-57 were pending and have been twice rejected. Claims 2, 19, 27 and 30-47 have been canceled. Claim 1 is an independent claim, and claims 3-18, and 20 depend from claim 1. Also, claim 21 is an independent claim, and claims 22-26 and 28-29 depend from claim 21. Finally, claim 48 is an independent claim and claims 49-57 depend from claim 48.

**Appellants Request Entry of the Amendments**

Appellants respectfully request entry of the amendments in the Amendment and Response Under 37 C.F.R. 1.116, filed on January 29, 2009. Appellants had proposed amendments to the specification on pages 22, 25, 28, and 35 to correct clerical errors. No new matter is added.

Appellants also respectfully request entry of the proposed claim amendments in the Amendment and Response filed on January 29, 2009, to place the application in condition for appeal. Appellants request claims 16 and 28 be amended to change dependency. Appellants also request that claim 2 be cancelled. Appellants believe that none of these amendments raise new issue not before considered and thus request entry of the amendments.

**Diaz Does Not Teach or Make Obvious the Features of the Claims**

The teachings of the Diaz U.S. Patent 5,690,674 are at issue in this Pre-Appeal Brief. Diaz is cited in combination with other references to reject all of the pending claims of the

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application. The Final Office Action mailed on October 29, 2008, sets forth on page 3 that “Diaz ‘674 discloses a wound closure device that contains a cutting mechanism (at distal end 302 of element 300, see Figure 5).” Appellants respectfully dispute this assertion and instead submit that Diaz does not teach a cutting mechanism at distal end 302, Figure 5, or anywhere else in the disclosure.

Diaz specifically teaches, “The sleeve 300 for one embodiment is a catheter sheath introducer inserted through a vessel wall 410 to provide access for instruments, such as guidewires, catheters, and balloon angioplasty devices for example, through the passageway 310 into the vascular system of the patient to perform a desired medical procedure.” (Column 4, line 66 to column 5, line 4.) The focus of Diaz is on a plug used to close a wound, and the sleeve 300 is employed to deliver the plug. There is no mention, or even suggestion, anywhere in the reference the sleeve 300 be used to create an opening in a patient.

The Advisory Action mailed February 17, 2009, sets out on page 3 “it is obvious that the tip of Diaz would be sharp because it is tapered and being sharp would aid in inserting the device 300 into the body.” Appellants traverse this statement. The mere fact that Figures 5-9 show a tapered end is not sufficient to suggest or make obvious the device is sharp. In the case of Diaz, the teaching of the entire reference makes clear the contrary.

The device 300 of Diaz is designed to be inserted into an incision already made with a surgical tool. And because the device of Diaz is a multi-purpose tool, it is too large and cumbersome to be used to perform specific incisions in a vessel wall. If the distal tip 302 was sharp, as indicated in the Advisory Action, inserting the device 300 into an already formed incision would damage the vessel. A tapered-only device would aid in insertion into the body. A tapered and sharp device, as suggested in the Advisory Action, would serve to damage the body where the device 300 is used to repair a wound or incision. There is absolutely no teaching that the distal tip 302 is sharp, and reason would dictate that a large, cumbersome device such as that taught in Diaz with a sharp distal tip would be dangerous and unproductive. Thus, Appellants submit that Diaz does not teach or make obvious a cutting mechanism.

The Advisory Action also sets out on page 3 “Diaz discloses a tapered tip (region of 302) that is capable of being used for cutting.” Appellants respectfully submit that one

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skilled in the art would not be inclined to use the device 300 to make cuts with a blunt sleeve because the teaching of Diaz is directed to a device used to plug a wound rather than to create a wound.

Further, Appellants submit that a blunt tapered tip capable of cutting would not meet the terms of the independent claims. For example, claim 1 sets forth “a cutting mechanism for creating the opening in the first blood vessel, the cutting mechanism comprising at least one electrode”; and claims 21 and 48 set forth “a cutting mechanism having at least one cutting blade for creating the opening in the first blood vessel.” Thus, in each independent claim, the blunt cutting tip by itself is not enough to meet the terms of the claim as an electrode or a cutting blade. There is no motivation or suggestion in the prior art to combine the device 300 of Diaz with a cutting blade or electrode because this would destroy the main principle of Diaz as a wound insertion and repair tool, rather than a wound creation tool. Thus, the allegation a blunt end could be used for cutting in order to combine the reference with a blade or electrode is inappropriate if the blunt end is not even contemplated for use as a cutting mechanism.

Based on the above, Appellants respectfully request the removal of Diaz as a reference, removal of the rejection, and allowance of the claims.

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**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 1, 3-18, 20-26, 28-29, and 48-57 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Request should be directed to Rudolph P. Hofmann at Telephone No. (612) 573-2010, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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